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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,075

11/25/2003

Yukiko Yoshida

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11/28/2007

STAAS & HALSEY LLP

SUITE 700

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,075	<b>Applicant(s)</b> YOSHIDA, YUKIKO	
	<b>Examiner</b> Traci L. Casler	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This action is in response to appears filed on August 31, 2007.

Claims 1 and 9-12 have been amended.

Claims 1-12 are pending.

Claims 1-12 are rejected.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants claims state "customizing values" which are used to develop and/or determine how the information is "customized" for the user. . . As for the limitation of "customizing and/or changing values" the specification fails to identify how the values are changed/customized using the conditions. What about the values is changing? If it's the user values how can the apparatus change them? How are these values determined? How does one determine the values, as in claim 11? How is data applied to determine a "value", limitation leads the examiner to believe some type of calculation must be performed but the disclosure fails to teach what or how the calculations are performed. Whether the value is being customized or determined the

same questions arise? How are they customised/determined and what is done to customize and/or determine?

1. Furthermore, in claim 12 applicant claims the limitation of "problem-solving process". Although applicant discloses a "problem-solving process" in the discloser applicant fails to identify what this process is and how it is applied. Therefore, the disclosure fails to enable one of ordinary skill in the art at the time of invention to make and or use applicants invention to obtain reproducible results and without undue experimentation. Applicants disclosure fails to teach how one skilled in the art is to know when a particular "problem solving process" is to be used and how exactly each problem solving process is to be implemented. The disclosure gives examples as "combination optimization" what is optimized, what combinations are used; "numerical calculations" there are infinite possibilities for a "numerical" calculation". And the process is according to the nature of the event, environmental conditions and user conditions. What/how are all these factors used for the "pre-determined" problem solving process.

***Claim Rejections - 35 USC § 103***

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,052,714 Miike et al; Information Filtering Apparatus and Method for Retrieving a Selected Article From Information Sources, hereinafter called Miike; in view of US Patent 6138142 Linsk; Method for providing customized web information based on attributes of the requester.

2. As to claims 1 and 9-12 An information providing apparatus and method that provides

information to a terminal of user through a network,

comprising:

-storage unit for storing environmental conditions that are predetermined conditions for an event relating information provided by predetermined

information provider; environmental conditions **being** Miike teaches an apparatus with a storage unit of predetermined conditions.(C.3 I. 32-36)

-a control unit for acquiring user conditions that are inputted by the user and that are the conditions relating and specific to the user, from the terminal of the user through the network; Miike teaches an apparatus with a unit for receiving conditions(C. 3 I. 48-49)

-a structuring unit for structuring, in conformity with the environmental conditions, detailed information that is the information corresponding the user conditions relating for the event, *including customizing values of the information*(Miike

**teaches ranking items according to the value determined by similarity C. 4**

**I. 5-6, 10-12)** Miike teaches an apparatus with a unit for querying information (C. 3 I. 62-63)

3. -the control unit distributes the detailed information to the terminal. Miike teaches an apparatus with a unit that distributes the information(C. 4 I. 7-9)

4. However, Miike fails to teach environmental conditions **applicable to a plurality of users** set by the information provider. Linsk teaches conditions determined by the

system that are based on the users geographic location(C. 3 I. 20-25). *The examiner notes the disclosure does not explicitly teach the information provider setting the pre-determined conditions; however, it is implied that if the customized information is based on the location and the user is supplied the closet retail store, the website creator(information provider) must have some type of information about that store already set to know it is the closest store to the user.* It would have been obvious to one of ordinary skill in the art at the time of invention to combine Linsk with Miike as requirements for laws governing the users location need to be followed.

5. As to claim 2 Miike teaches an apparatus with a storing unit and a unit to perform query(C. 4 . 7-12)

and allows user to alter extracted information(C. 7 I. 57-60).

6. As to claims 3 and 4 Miike teaches an apparatus with a unit executing a program in response to conditions(C. 3 I. 47-49)

7. As to claim 5 Miike teaches an apparatus with a unit that can create a value to determine information(C. 4 I. 1-4)

8. As to claim 6 Miike teaches an apparatus with changing conditions and recreating detailed information that is distributed to the user(C. 7 I. 65-67; C. 8 I. 1-2).

9. As to claim 7 Miike teaches an apparatus providing a news article as the information(c. 3 I. 2-4).

10. As to claim 8 Miike teaches an apparatus linked via a network(c. 3 I. 10-11)

***Response to Arguments***

2. Applicant's arguments filed August 31, 2007 have been fully considered but they are not persuasive.

3. As to applicants arguments regarding rejections under 35 USC 112 1st paragraph. The examiner notes the written description portion of the rejection is withdrawn as applicants amendments have overcome the rejection. However, the enablement rejections are maintained.

4. Applicant argues that the examiner has "mistaken" the user conditions for which values are customized. The examiner notes the claim limitations with respect to customizing the values read "customizing the values of the information with resepet to the user in accordance with the USER CONDITIONS(claim1); "APPLYING user set conditions...to predetermined conditions defined by an information provider TO customize the information INCLUDING the valuses"(claim 9); "customizing the Data INCLUDING values ...responsive to a request from the user, the data being customized(which includes values) in accordance with conditions SPECIFIC to user"(claim 10); determining values forming the information by APPLYING user specific data input";(calim 11); Based on the above noted limitations the examiner fails to see how "values" are not customized using the user conditions. The applicants arguments further support the examiners questions that some type of calculation must be performed in order to determine a value. If not then the values are simply information that is match; not determined or customized(values don't change). The applicants arguments with regard to the example of telephone company charges are narrower than

the limitations as claimed; the limitations of environmental conditions as disclosed are merely conditions not set by the user the environmental conditions as claimed have nothing to do with charges, service areas; the environmental conditions can simply be a topic or a category for which an article or a product fall into; the disclosure does not limit the definition of environmental conditions; examples re given but it is an open limitation not a closed limitation to only "regional" or "geographical" limitations.

5. As to applicants arguments regarding the enablement of claim 12 and the limitation of "problem solving process". The Applicant points to several sections where there is "support" for problem solving processes. The examiner notes that the disclosure does discuss the use of SEVERAL pre-determined problem solving processes the disclosure fails to set forth how one would now what "predetermined process" is to be used and how to apply that predetermined process. The examiner above has attempted to clarify the rejection, indicating that the disclosure teaches a problem solving process as "numerical calculations"; however, one of ordinary skill in the art would have no way of knowing of the infinite possibilities of the calculations, which calculation to apply and when to apply a numerical calculations verses the other suggested/examples of problem solving processes.

6. As to applicants arguments regarding the art rejection under 35 USC 103. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicants arguments simply state what Miike teaches and restates the



limitations as read in the claims without elaborating how the language is different than that of Miike and Linsk. The examiner has attempted to clarify and elaborate In the above rejection of how the prior art is being interpreted in accordance with the claim language. The applicant argues that Linsk fails to teach the conditions as pre-determined by the system(information provider) as noted by the examiner in C. 3 I. 20-25; as noted above the prior art *does not explicitly teach the information provider setting the pre-determined conditions; however, it is implied that if the customized information is based on the location and the user is supplied the closet retail store, the website creator(information provider) must have some type of information about that store already set to know it is the closest store to the user*

7. AS to Applicants arguments regarding the motivation to combine; the applicant argues that the "alleged" motivation of "legal requirements" or censoring as applicant terms it is not found in either reference. The examiner draws the attention to C. 3 I. 31-40 Content Law; of Linsk in which linsk discusses material not meeting international laws based on content and using geographic attributes of requesters to determine If information is or is not restricted.

8. Furthermore, the examiner notes as supported the supreme court decision in KSR international; the motivation for combining is not required to be found in the prior art themselves but rather the known to those skilled in the art to yield predictable results. As Miike and Linsk are both method and systems to provide customized information to a user it would have been obvious to one skilled in the art that were previously known in the art.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

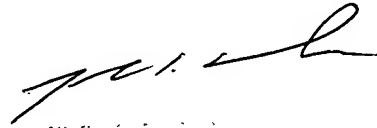
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/720,075  
Art Unit: 3629

Page 10

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TLC

A handwritten signature in black ink, appearing to be "J. L. Smith", is written over a faint, illegible printed name.